



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/036,236	03/06/1998	DAVID M. OLIVER	005-905-300	5721

20433 7590 02/04/2005

BLODGETT BLODGETT
43 HIGHLAND STREET
WORCESTER, MA 016092797

EXAMINER

SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/036,236

Applicant(s)

OLIVER ET AL.

Examiner

Jeffrey A. Smith

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

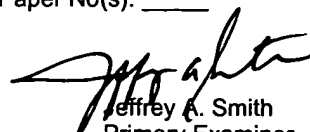
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Attached PTO-892.


Jeffrey A. Smith
Primary Examiner
Art Unit: 3625

Continuation of 11. does NOT place the application in condition for allowance because:

Examiner's remarks at Section 7 inconsistent with "on-sale" bar: The Examiner's position on these issues are not inconsistent. At Section 7 the Examiner indicates that Applicant has failed to make adequate showing regarding priority of invention; while the rejection under 102(b) using 10/24/1995 press release offers evidence that the invention was ready for patenting and has effected the "on-sale" bar trigger of 102(b). The Examiner's provision of evidence of a public sale does not serve to fulfill Applicant's burden in establishing adequate showing of priority of invention.

Arguments in support of "experimental use": Such arguments are not persuasive. Ref. U (PTO-892, provided herewith) identifies that "alpha testing" was for the purpose of "[evaluating] the system at no charge for three months". Evaluation of the system for a predetermined time (such as the identified three months) implies that Clickshare was beyond a state at which it was reducing the system to practice, but was, rather, establishing a period in which they could solicit feedback regarding suitability of the system for assessing customer needs. *LaBounty Mfg. Inc. v. United States ITC*, 958 F.2d 1066 (Fed. Cir. 1992). Moreover, the reference states that participants in the "alpha testing" would not be charged for three month. This implies that some charges should be expected after the expiration of the three-month evaluation. Additionally, Clickshare advertised in its solicitation for partners in the "alpha testing" that they would receive discounted fees on their first-year member fees. This constitutes an offer to sell memberships in the system upon a publisher's or ISP's acceptance as a participant in the "alpha testing" (see MPEP 2133.03(b)(II)). Further to the issue of "ready for patenting", Ref. U quotes Mr. Oliver (one of the named inventors) as stating "While the system as introduced at beta will be capable of handling payment transactions, we want to give it a workout before doing so". The beta product was made available prior to Jan 1, 1996 (see Ref. V, provided herewith). These citations provide evidence that the system was "ready for patenting" prior to Jan. 1, 1996 (i.e. more than one year prior to Applicant's priority date of March 7, 1997). Finally, it is noted that the various references and press releases cited (here and previously) show evidence that Applicant failed to maintain control of any purported "experimental use" by openly broadcasting great detail regarding both the invention and the intent of the invention. Such broadcasts had the effect of generating consumer interest in membership in the system--such as by offering membership discounts as an "early-in-type" of incentive (Ref. U). Such an overt commercial exploitation cannot be viewed as being unintended or incidental (MPEP 2133.03(e)).